

REMARKS

No claims are amended, claims 6-15, 26-31, 39-41, 47-49, 53-54, 60-61, and 64-69 are canceled, and no new claims are added; as a result, claims 1-5, 16-25, 32-38, 42-46, 50-52, 55-59, and 62-63 are now pending in this application.

Information Disclosure Statement

Applicant respectfully requests that a copy of Form 1449, listing all references that were submitted with the Information Disclosure Statement filed on May 04, 2004, marked as being considered and initialed by the Examiner, be returned with the next official communication.

§102 Rejection of the Claims

Claims 1-5, 16-25, 32-38, 42-46, 50-52, 55-59 and 62-63 were rejected under 35 U.S.C. § 102(e) as being anticipated by Halliday *et al.* (U.S. 5,880,740). Applicant does not admit that Halliday *et al.* is prior art, and reserves the right to swear behind Halliday *et al.* as provided for under 37 C.F.R. § 1.131. Applicant respectfully traverses the rejections of claims 1-5, 16-25, 32-38, 42-46, 50-52, 55-59 and 62-63.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

Claim 1 recites, "communicating a selection of the first image and the second image to a server via a network; automatically generating a composite image of the first image and the second image at the server." In contrast, Halliday *et al.* at column 3, lines 9-13, states, "The

composite image seen in FIG. 1 is displayed on a computer display screen, in the manner to be described, and is modified by a user who uses a mouse of the like to point to and *select a particular zone.*" (emphasis added) Thus, Halliday *et al.* fails to teach, "communicating a selection of the first image and the second image to a server via a network; automatically generating a composite image of the first image and the second image at the server," as recited in claim 1.

The Office Action, on page 3, states that Halliday *et al.* discloses, "communicating (internet 105 is used for communication between the server and clients) a selection of the first image (13, 15, 31) and the second image (11, 21) to a server (155, 157) via a network (105 in figure 10 provides internet)." Applicant respectfully disagrees. Halliday *et al.* at column 7, lines 7-9, states, "FIG. 10 of the drawings which shows a pair of computer workstations 101 and 103 connected via the Internet 105," and further at column 7, lines 30-38, "The workstations 101 and 103 both have access to information stored on HTTP (HyperText Transport Protocol) web servers as illustrated by the server indicated at 155 which provides web page information from a disk storage unit 156 and on FTP (File Transfer Protocol) file servers of the type illustrated at 157 illustrated as connected to a disk storage units 161 which stores utility programs (composite image authoring and viewing programs) as well as composite image sets." However, Halliday *et al.* fails to teach, "communicating a selection of the first image and the second image to a server via a network," as recited in claims 1. (emphasis added) In addition, Halliday *et al.* at column 7, lines 15-19, states, "The workstation 101 consists of a conventional personal computer 111 provided with local read/write disk storage, such as a hard disk drive, at 113 and a CD-ROM player 115, *both of which store individual image elements* used to form composite images." (emphasis added) Hence, Halliday *et al.* fails to teach "automatically generating a composite image of the first image and the second image at the server." (emphasis added)

Thus, Halliday *et al.* fails to teach all of the elements of claim 1. Therefore, the Office Action has failed to state a *prima facie* case of anticipation with regards to claim 1. For at least the reasons stated above, Applicant respectfully requests withdrawal of the rejection and reconsideration and allowance of claim 1.

Claims 2-5 and 16-20 depend from claim 1, and therefore are patentable over Halliday *et al.* for the reasons argued above, plus the elements in the claims. Therefore, Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 2-5 and 16-20.

For reasons analogous to those recited above with regards to claim 1, Applicant respectfully submits that Halliday *et al.* fails to teach the elements of claims 21, 34, 42, 50, and 57, as quoted above. Claim 21 recites, "receiving a first image and a second image at a server from a browser responsive to a user-selection of the first image and the second image; automatically generating a composite image of the first image and the second image at the server." Claims 34 and 42 recite, "communicating a selection of the first image and the second image to a server via a network; receiving a composite image of the first image and the second image from the server at the browser via the network." Claim 50 recites, "a server to receive a user selection of the first image file and the second image file and to generate a composite image of a first image and a second image." Claim 57 recites, "means for communicating a selection of the first image and the second image to a server via a network; means for automatically generating a composite image of the first image and the second image at the server." Thus, Halliday *et al.* fails to teach each of the elements of claims 21, 34, 42, 50, and 57. Therefore, the Office Action has failed to state a *prima facie* case of anticipation with regards to claims 21, 34, 42, 50, and 57. For at least the reasons stated above, Applicant respectfully requests withdrawal of the rejection and reconsideration and allowance of claims 21, 34, 42, 50, and 57.

Claims 22-25 and 32-33 depend from independent claim 21; claims 35-38 depend from independent claim 34; claims 43-46 depend from independent claim 42; claims 51-52 and 55-56 depend from independent claim 50; and claims 58-59 and 62-63 depend from independent claim 57. Hence, these claims contain all the elements of the respective independent claim from which they depend, and thus are patentable over Halliday *et al.* for the reasons argued above, plus the elements in the claims. Therefore, Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 22-25, 32-33, 35-38, 43-46, 51-52, 55-56, 58-59, and 62-63.

Allowable Subject Matter

Claims 6-15, 26-31, 39-41, 47-49, 53-54 and 60-61 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 6-15, 26-31, 39-41, 47-49, 53-54 and 60-61 are canceled without prejudice, so the objection to these claims is moot.

Claims 64-69 were allowed. Claims 64-69 are canceled without prejudice, so the allowance of these claims is moot.

The Applicant reserves the right to reintroduce claims 6-15, 26-31, 39-41, 47-49, 53-54, 60-61, and 64-69 in later applications.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9592 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date Nov. 29, 2004

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CERTIFICATE UNDER 37 C.F.R. § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29th day of November, 2004.

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